

**REMARKS**

Claims 1-15 are pending in the application. Claims 1-15 have been examined.

**35 U.S.C. §112:**

Claims 9 and 10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Accordingly, these claims, along with claim 14, are amended to delete the phrase “member selected from the group consisting essentially.” Thus, the rejection of claims 9 and 10 is deemed to be overcome, and withdrawal of the rejection is requested.

**35 U.S.C. §103:**

Claims 1-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sullivan (U.S. Patent Nos. 6,204,331 and 6,162,134) in view of Ueshima et al. (U.S. Patent No. 5,502,095 [hereinafter “Ueshima”]). Applicants respectfully traverse this rejection in view of the following remarks.

The Examiner asserts that Ueshima discloses a thermal plastic elastomer composition consisting of component (C), polyorganosiloxane. Polyorganosiloxane is blended with resin or rubber or filler such as a silicone rubber powder (column 6, lines 61-65). Ueshima further teaches that this blended composition can be used as an element material for sport and leisure goods (e.g., golf club grip, baseball bat grip, swimming and etc.) and other rubber contacts. Thus, the Examiner alleges that it would have been obvious to include the silicone rubber powder of Ueshima into a silicone resin of Sullivan to provide a golf ball with improved flexibility, ease of molding, and high resilience.

However, it is important to note that the silicone powder disclosed in Ueshima is never used alone or taught to be separated from the polyorganosiloxane. Instead, it is explicitly taught to be an integral part of a master batch in which the polyorganosiloxane is blended therein. (See column 6, lines 61-65.) There is no motivation to first separate the powder from the polyorganosiloxane in Ueshima and then combine the powder with the silicone resin of Sullivan. It is not taught that the powder alone in Sullivan provides the alleged “improved flexibility, ease of molding, and high resilience,” but instead, it is the disclosed thermoplastic elastomer composition as a whole. (See col. 11, lines 21-27.) Further, the silicone rubber powder in Ueshima is described as merely one example of a filler that can be used together with other compounds equivalently. Thus, one skilled in the art would not have selectively taken the resin powder of Ueshima and combined it with the golf ball of Sullivan.

Further, there is no motivation to incorporate the combination of polyorganosiloxane and the rubber powder of Ueshima, into Sullivan. For example, Ueshima describes in column 6, lines 61-65 that: “[I]n practical use, in view of workability and dispersibility, the polyorganosiloxane ‘C’ is more preferably a master batch.” (Emphasis added.) Thus, the master batch is directed towards “workability and dispersibility.” In short, the function for blending a silicone rubber powder (one of various disclosed fillers) is only to enhance the workability and dispersibility, and one would not expect the beneficial effects of the present invention. Thus, the effect given by the powder in the claimed invention provides results that would not be expected from a combination of the polyorganosiloxane and powder of Ueshima with Sullivan.

Applicants respectfully direct the Examiner's attention to the fact that an alleged *prima facie* case of obviousness may be rebutted by demonstrating that the claimed invention achieves superior results that are unexpected from the prior art. To provide further support of the unexpected results achieved by the present invention, Applicants submit herewith a paper authored by Yasushi Ichikawa, one of the co-inventors of the present invention. This paper compares the invention having a silicone rubber powder in a cover verses a "Comparison," which does not contain a silicone rubber powder. The golf ball of Sullivan corresponds to the Comparison because Sullivan discloses general silicone elastomers (not powder form). Thus, it can be seen that the difference between using the silicone rubber powder versus the silicone rubber without the powder, brings about significant differences in the flight performance and durability against consecutive strikes (please see results of the Table of the Declaration). Ueshima does not teach or suggest that its disclosed materials would supplement Sullivan to provide the effects of the present invention. Thus, in addition to the agreements presented above, the present invention provides benefits that would not have been expected from a combination of the applied references.

Accordingly, one skilled in the art would not have been motivated to combine the references so as to derive the features of the present invention, and the rejection of the claims under 35 U.S.C. §103(a), should be withdrawn.<sup>1</sup>

---

<sup>1</sup> Applicants note that the grounds of rejection is incomplete because it only states that claims 1-10 are rejected.

AMENDMENT UNDER 37 C.F.R. §1.116  
U.S. Application No.: 09/732,786

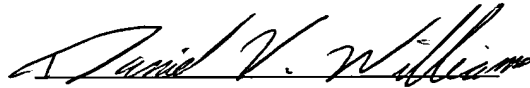
Art Unit 3711  
Q62216

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the local telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

  
Daniel V. Williams  
Registration No. 45,221

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: December 20, 2002

**APPENDIX**  
**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

9. (Twice amended) The golf ball of claim 1 wherein the golf ball-forming composition is at least one [member selected from the group consisting essentially] of a one-piece golf ball material, a core material and a cover material for a two-piece golf ball, a core material, an intermediate layer material and a cover material for a multi-piece golf ball having at least three pieces.

10. (Twice amended) The golf ball of claim 1 wherein the golf ball-forming composition is based on at least one [member selected from the group consisting essentially] of an ethylene ionomer resin, polyurethane elastomer, polyolefin elastomer, polyamide elastomer, polyolefin resin, and styrene block copolymer.

14. (Amended) A golf ball comprising a portion formed of a golf ball-forming composition based on at least one [member selected from the group consisting essentially] of an ethylene ionomer resin, polyester elastomer, polyurethane elastomer, polyolefin elastomer, polyamide elastomer, polyolefin resin, and styrene block copolymer which has blended therein at least one of a silicone rubber powder, a silicone resin powder, and a composite powder thereof.